

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,821	12/26/2001	Satoshi Shinada	Q67781	4266
7590 01/03/2005			EXAMINER	
Sughrue SUGHRUE MION PLLC			LIANG, LEONARD S	
2100 Pennsylvania Avenue, NW			ART UNIT	
Washington, DC 20037-3213			PAPER NUMBER	
			2853	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/025,821	Applicant(s) SHINADA ET AL.	
	Examiner Leonard S Liang	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27, 29-60 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I directed to figures 1-2.

Species II directed to figure 9.

Species III directed to figure 10.

Species IV directed to figure 13.

Species V directed to figure 15A.

Species VI directed to figure 15B.

In addition to the above species requirement, which is directed to different ink cartridges, the following species requirement as directed to different cartridge-loading processes is also required:

Species A directed to figure 3.

Species B directed to figures 11A-B.

Species C directed to figure 16.

In addition to the above species requirements, the following species requirement as directed to storage means is also required.

Species a directed to figures 4A-B.

Species b directed to figure 14.

Species C directed to figures 17A-B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-26 and 29-31 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A species election requirement based on the drawings was not previously made because it was believed that all claims were generic. However, based on careful examination of the applicant's newly submitted claims, as well as the applicant's arguments, this is found to not be the case. For example, with regards to claims 29-31, the applicant directs the examiner's attention to figures 15A-15B. However, it is clear to the examiner that figures 15A-15B

Art Unit: 2853

represent different species from figures 1-2, 9-10, and 13. Furthermore, it looks as if claims 29-31 only read on figures 15A-15B, and do not read on the other figures. In regards to the applicant's newly filed claims 32-60, there is no disclosure of a "third horizontal width" in the specification. In order to justify these new claims as not being new subject matter, the applicant submitted that "claim 33 is inherently disclosed in the original disclosure because one skilled in the art would easily recognize that each of the electrodes have a third horizontal width along the carriage moving direction that is substantially equal to or greater than a difference between the first horizontal width of the recess and the second horizontal width of the positioning member..." The applicant backs up this claim by using figure 10 for demonstration. However, though the applicant's arguments of inherency seem sufficient in light of figure 10, the examiner is skeptical whether the newly submitted claims would be necessarily inherent in light of all the other figures (such as figures 1-2, 9, 13, and 15A-B). If applicant's claims are not inherent for all species, then the applicant has introduced new subject matter into the specification. These are the reasons why the examiner has made a species election requirement. The applicant is required to inform the examiner which claims correspond to which figures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S Liang whose telephone number is (571) 272-2148. The examiner can normally be reached on 8:30-5 Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lsl

LSL


Stephen D. Meier
Primary Examiner